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In re Application of:	:	
SUMI, Naoki	:	DECISION ON PETITION
U.S. Application No.: 10/540,384	:	(37 CFR 1.137(b))
Int'l Application No: PCT/JP2003/016652	:	
Int'l Filing Date: 24 December 2003	:	
Priority Date: 27 December 2002	:	
Atty Docket No.: JP02 0029 US	:	
For: METHOD FOR MANUFACTURING	:	
ELECTRONIC DEVICE AND	:	
ELECTRONIC DEVICE	:	

This decision is issued in response to applicant's Petition for Revival under 37 CFR 1.137(b) filed 21 June 2007. Applicant has paid the required petition fee.

**BACKGROUND**

On 24 December 2003, applicant filed international application PCT/JP2003/016652. The application claimed an earlier priority date of 27 December 2002 and it designated the United States. On 22 July 2004, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for filing the basic national fee was thirty months from the priority date, i.e., 27 June 2005.

On 22 June 2005, applicant filed a Transmittal Letter requesting entry into the U.S. national stage accompanied by, among other materials, payment of the basic national fee.

On 22 December 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that a translation of the international application into English, an oath or declaration in compliance with 37 CFR 1.497, and the surcharge and processing fees for filing these materials later than thirty months after the priority date were required.

On 04 January 2006, applicant filed a response to the Notification Of Missing Requirements that included an executed declaration, payment of the required surcharge and processing fee, and an English translation of the specification, claims, and abstract. However, the submission did not include an English translation of the drawings.

On 31 July 2006, the DO/EO/US mailed a "Notification Of Acceptance" (Form PCT/DO/EO/903) indicating that applicant had complied with the requirements of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) as of 04 January 2006.

On 21 November 2006, the DO/EO/US mailed a "Withdrawal Of Previously Sent Notice" indicating that the Notification Of Acceptance mailed 31 July 2006 had been issued in error and was therefore withdrawn. Also on 21 November 2006, the DO/EO/US mailed a "Notification Of Defective Response" (Form PCT/DO/EO/916) indicating that the previously filed English translation of the international application was defective for failure to include a translation of the drawings. The Notification provided a non-extendable one-month response period.

Applicant did not file a response to the Notification Of Defective Response during the one-month response period. Accordingly, the present application became abandoned at midnight on 21 December 2006.

On 20 April 2007, the USPTO mailed an Office Action containing a restriction requirement.

On 21 June 2007, applicant filed the petition for revival considered herein accompanied by, among other materials, a purported translation of the drawings into English.

### DISCUSSION

37 CFR 1.137(b) permits the filing of a petition to revive an abandoned application where the abandonment resulted from an unintentional delay. A grantable petition under this section must include: (1) the required reply, unless previously filed; (2) the petition fee required by law; (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional;" and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). It is noted that item (4) does not apply to the present application.

With respect to item (1), the "required reply" is a proper response to the Notification Of Defective Response mailed 21 November 2006, that is, an English translation of the drawings. Applicant's petition includes an English translation of 99 out of the 100 drawings herein; however, applicant has not submitted a translated version of Figure 82. Applicant must submit an English translation of Figure 82 to complete the "required reply." Until such translation is submitted, item (1) above is not satisfied.

With respect to item (2), applicant has paid the required petition fee. Item (2) is therefore satisfied.

With respect to item (3), the petition includes the required statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. However, the statement of unintentional delay was executed by an attorney who was not of record at the time the application became

abandoned. Such attorney was appointed herein on 23 May 2007 by an assignee, TPO Hong Kong Holding Company ("TPO"), that took ownership of the application after the application became abandoned. Under these circumstances, it is not apparent that the person signing the statement of unintentional delay is in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue.

The statement in the present petition is sufficient to conclude that the delay in filing the petition from the time above-named counsel became responsible for the application in May 2007 until the filing of the present application on 21 June 2007 was unintentional. However, it is not sufficient to support a conclusion that the delay during the period between the mailing of the Notification Of Defective Response on 21 November 2006 and above-named counsel's acceptance of responsibility herein in May 2007, a period during which the application was owned by a different assignee and was being handled by separate counsel, was also unintentional.

Before it can be concluded that the entire delay herein was unintentional, applicant must provide additional materials confirming that the delay in filing the required reply between the mailing of the Notification Of Defective Response on 21 November 2006 and above-named counsel's acceptance of responsibility herein in May 2007 was unintentional. Such materials should include a statement from prior counsel explaining the delay during this period, since such person(s) would presumably have firsthand knowledge regarding the cause of delay during this time period.

Based on the above, applicant has not satisfied items (1) and (3) of a grantable petition for revival under 37 CFR 1.137(b). Accordingly, applicant's petition cannot be granted on the present record.

Finally, because the present application became abandoned as of 21 December 2006, the subsequent mailing of an Office Action on 20 April 2007 was inappropriate. The Office Action mailed 20 April 2007 is therefore properly vacated.

### **CONCLUSION**

Applicants' petition for revival under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any request for reconsideration should be entitled "Renewed Petition Under 37 CFR 1.137(b)" and it must include the materials required to satisfy items (1) and (3) of a grantable petition, as discussed above. No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

The Office Action mailed 20 April 2007 is hereby **VACATED**.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration



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